

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JAN. 5, 00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Heartstent Corporation

Serial No. 75/168,250

John A. Clifford of Merchant Gould Smith Edell Welter & Schmidt,
P.A., for Heartstent Corporation.

Ira J. Goodsaid, Senior Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Simms, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Mark B. Knudson, Ph.D., filed an application for
registration of the mark "HEARTSTENT" for "medical implants used
to perform coronary bypass surgery, namely, rigid conduits for
surgical implantation for creating a fluid passageway between a
heart ventricle and a coronary artery downstream from a coronary
obstruction," in International Class 10.¹

¹ Serial No. 75/168,250, filed September 18, 1996, based upon an
allegation of a *bona fide* intention to use the mark in commerce. The
assignment of this application to Heartstent Corporation was recorded
in the U.S. Patent and Trademark Office on November 24, 1997 at Reel
1660, Frame 0470.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that if applicant's proposed mark "HEARTSTENT" were used on this medical implant, it would be merely descriptive of applicant's device.

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We reverse the refusal to register.

In the first Office action, the Senior Trademark Examining Attorney simply takes the position that "[t]he goods are stents for use in the heart - i.e., heart stents."

However, applicant argues in return that a rigid conduit from the heart ventricle to a coronary artery is not a "stent." Rather, applicant argues that a stent is an endovascular prosthesis totally enclosed within a coronary artery. In fact, a stent for the treatment of cardiovascular disease is a slotted tube, a wire mesh or spring-like spiral frame made of surgical-grade stainless steel. The stent is placed in a coronary vessel of selected patients by an interventional cardiologist after balloon angioplasty to prevent closure of the blood vessel. After the stent is deployed to the desired location within a coronary artery, it is then expanded into a frame providing mechanical support to the wall of the artery. Generally this

structure is permanently incorporated into the wall of the blood vessel.²

Applicant argues that if one must assign a generic name to the instant device, it would most accurately be categorized as a heart "shunt." A shunt is a tube that serves as a collateral circulatory route, or as an abnormal junction, short circuit or by-pass between two body cavities and/or passages that allows the contents (e.g., in the instant case, blood) of one cavity (e.g., the heart ventricle) to pass to the other passage (e.g., the coronary artery), bypassing the normal channel (e.g., the obstructed portion of the occluded blood vessel). While a stent is porous, is confined to the inner open cavity of a blood vessel and is designed to "expand," applicant notes that its rigid conduit is not porous, is not confined to the inner open

² We take judicial notice of a number of medical dictionaries that supplement those placed in the record by the applicant and the Trademark Examining Attorney:

coronary stent - Intracoronary stent. A tubular device left in a lumen to maintain its patency; clinical and angiographic outcomes are better with intracoronary artery stent implantation than with standard balloon angioplasty, at a cost of ↑↑↑ vascular complications and ↑ hospital stay (cite omitted), a lower rate of restenosis and need for revascularization (cite omitted). Current Med Talk - A Dictionary of Medical Terms, Slang & Jargon, 1995, p. 189.

stent, intraluminal coronary artery - A stent made of stainless steel with a self-expanding mesh introduced into the coronary artery. Used to prevent lumen closure (restenosis) following bypass surgery and to treat acute vessel closure after angioplasty. Taber's Cyclopedic Medical Dictionary, F.A. Davis Co., p. 1871.

cavity of a blood vessel and does not expand (i.e., it is more in the nature of a solid tube or catheter).³

While one dictionary entry made of record described stents as being "expendable," the Trademark Examining Attorney argues in the Final Office action that the fact applicant's device is designed to become a permanent part of the patient's circulatory system is irrelevant to the legal issue presented herein under Section 2(e)(1) of the Act.⁴

³ Again, we take judicial notice of a number of medical dictionaries that supplement those placed in the record by the applicant and the Trademark Examining Attorney:

shunt - A short circuit or bypass, usually between blood vessels. See also surgery. Lexikon, Dictionary of Health Care Terms, Organizations, and Acronyms for the Era of Reform, 1994, p. 724.

shunt - The diversion of the flow of a fluid, which may be accidental... or occur by design ... Current Med Talk - A Dictionary of Medical Terms, Slang & Jargon, 1995, p. 815.

shunt - (1) To bypass or divert. (2) A bypass or diversion of accumulations of fluid ... Stedman's Medical Dictionary, 26th Edition, 1995, p. 1609.

shunt vessel -- A blood vessel which enables shunting to take place. The shunt vessel forms a by-pass channel in the blood circulation, connecting two anatomical channels and diverting blood from one region to the other. See also anastomosis. The Oxford Dictionary of Sports Science and Medicine, 2d Edition, 1998, p. 459.

anastomosis: (1) A union or joining together of blood vessels or other tubular structures. Anastomosis usually refers to the direct connection between arteries, veins, venules, and arterioles without any intervening capillaries... (2) A surgical union of two tubular structures, usually by sutures or staples. The Oxford Dictionary of Sports Science and Medicine, 2d Edition, 1998, p. 32.

⁴ The exchanges between applicant and the Trademark Examining Attorney over whether stents are generally "expandable" and/or "expendable" did little to help us resolve the sole issue before us. It is also possible that this cited dictionary entry contains a misprint (e.g., incorrectly used the word "expendable" when it intended the word "expandable").

In fact, applicant and the Trademark Examining Attorney seem to agree that the sole issue in this appeal is whether the term "heart stent" is descriptive of a feature, function, or characteristic of applicant's device.

As the court said in In re Automatic Radio Manufacturing Co., 404 F.2d 1391, 1396, 160 USPQ 233, 237 (CCPA 1969):

It seems elementary that one must find out how people in the trade and the purchasers use the terms with respect to the involved goods in order to determine whether or not they are descriptive.

See also Application of Andes Candies, Inc., 478 F.2d 1264, 1266, 178 USPQ 156 (CCPA 1973); Callman, "Unfair Competition and Monopolies," §18.04 at 13 ("Whether a particular word is understood as descriptive will be determined by the reaction of those to whom the trademark is directed in the marketplace. If a considerable portion of the purchasing public considers the word descriptive, then it is so...").

Based on the instant record, it appears that both words herein, i.e., "heart" and "stent," have well-understood meanings. In the specialized worlds of cardiovascular mechanics and internal medicine, widespread use of the words "heart" and "stent" would clearly preclude applicant from claiming exclusive right to register those words (either as a compound word or as two separate words) as a source-identifier for coronary stents. In fact, as applied to coronary stents, this terminology would

be highly descriptive, if not generic.⁵ However, we are asked to determine on this record whether the term would be merely descriptive as applied to applicant's somewhat different device.⁶

We note that merchants and manufacturers may combine common, ordinary words in a novel or unique way, thereby obtaining for the term a degree of protection denied to words when used separately, or when used in a somewhat different context. Accordingly, we are faced with the question of whether, in adopting this specific formulation, applicant has created an incongruous meaning for the combined phrase as applied to the identified device.

In a case such as this one, it may well be tempting to decide that if a given term is generic as to one item of merchandise, then it cannot function as a valid trademark for related items of merchandise. However, we can find no reported decisions where our principal reviewing court has

⁵ The instant case seems analogous to a prior Board decision in the case of In re Hit Sales Corporation, 170 USPQ 49 (TTAB 1971) ["DIAMOND CUT" registrable for inexpensive jewelry items]:

"Here, while it is admittedly true that 'DIAMOND CUT' is the generic name for a type of diamond or cut and would therefore be unregistrable for a diamond or jewelry containing a diamond, we are of the opinion that there is no close relationship in the public mind between such goods and applicant's jewelry items containing business insignia which do not contain gems or stones. In other words, it is our conclusion that 'DIAMOND CUT' is neither generic, merely descriptive, or deceptively misdescriptive as applied to applicant's goods."
supra, at 50.

⁶ We also note that because no refusal was made herein that this term would be deceptively misdescriptive as applied to applicant's goods, we do not need to address that issue herein.

ever countenanced this simple formulation, i.e., if a given term is generic as applied to one item of merchandise, then it is merely descriptive for a related item of merchandise.

To the contrary, applicant argues as follows:

... Applicant acknowledges that a merely descriptive term is not registerable... While a descriptive term immediately tells something about the goods or services, 'a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.' TMEP §1209.01(a). Applicant relies upon *In re Shutts*, 217 USPQ 363 (TTAB 1983). In this case, the Board evaluated a refusal for an application for SNO-RAKE. In its analysis, the Board stated that although combining each term's dictionary definition resulted in a description of the product, the terms did 'not readily and immediately evoke an impression and understanding of applicant's implement as a snow removal device.' *In re Shutts* at 364. Applicant asserts that HEARTSTENT does not readily and immediately evoke an impression and understanding of Applicant's product...

Given the circumstances of this case, we find this argument persuasive. A stent is simply not a shunt. There is nothing in the record leading us to conclude that for cardiologists and other members of the relevant public, a coronary "stent" would be understood as including applicant's solid, tubular device. While we are not totally free of doubt, we are compelled on the record before us to reverse the Trademark Examining Attorney, being mindful of the advice of the late Saul Lefkowitz:

The distinction between marks which are 'merely descriptive' and marks which are 'suggestive' is so nebulous that more often than not it is

determined largely on a subjective basis with any doubt in the matter being resolved in applicant's behalf on the theory that any person who believes that he would be damaged by the registration will have an opportunity under Section 13 to oppose the registration of the mark and to present evidence, usually not present in the *ex parte* application, to that effect.

In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Decision: We reverse the refusal of the Trademark Examining Attorney to register this matter under Section 2(e)(1) of the Act.

R. L. Simms

D. E. Bucher

C. M. Bottorff

Administrative Trademark Judges,
Trademark Trial and Appeal Board